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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/730,077	12/09/2003	Yuuji Sawai	245246US2CONT	2773
22850	7590	04/26/2005	EXAMINER	
OBLON, SPIVAK, MCCLELLAND, MAIER & NEUSTADT, P.C. 1940 DUKE STREET ALEXANDRIA, VA 22314			LEE, SUSAN SHUK YIN	
			ART UNIT	PAPER NUMBER
			2852	
DATE MAILED: 04/26/2005				

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No. 10/730,077	Applicant(s) SAWAI ET AL. 	
	Examiner Susan S. Lee	Art Unit 2852	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 28 October 2004.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-39 is/are pending in the application.
- 4a) Of the above claim(s) 19-39 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-6 and 15-17 is/are rejected.
- 7) ☒ Claim(s) 1-18 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 09 December 2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☒ Certified copies of the priority documents have been received in Application No. 09/696,959.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>3 sheets</u> . | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Election/Restrictions***

Claims 19-39 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in the reply filed on 10/28/04.

Applicant's election with traverse of claims 1-18, group I in the reply filed on 10/28/04 is acknowledged. The traversal is on the ground(s) that applicant states that "it appears that these claims according to the present invention are part of an overlapping search area". This is not found persuasive because a complete search for group I requires a different complete search than what is required for group II. They are also independent and distinct inventions.

The requirement is still deemed proper and is therefore made FINAL.

### ***Drawings***

The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the "restriction portion, which restricts an image transfer side of the recording medium, other than opposite ends in direction of conveyance" (claim 18) must be shown or the feature(s) canceled from the claim(s). No new matter should be entered. Figure 5 shows the restriction portion 22b contacting the trailing end of the image transfer side of the recording medium.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

### ***Claim Objections***

Claims 1-18 are objected to because of the following informalities:

As to claim 1, line 2, "forma" is incorrect.

As to claim 2, line 2, "the training edge" is incorrect.

As to claim 2, line 2, "f rom" is incorrect.

As to claim 3, line 3, "f ree" is incorrect.

As to claim 15, line 2, "the hip" is incorrect. It should be - - the nip - - .

As to claim 18, line 9, "of." is incorrect.

As to claim 18, lines 5-10, "restricting portion, ... in said direction of conveyance" is unclear. The entire claim 18 seems like a long run-on sentence.

Appropriate correction is required.

### ***Specification***

The abstract of the disclosure is objected to because it does not describe the invention that is now claimed. Correction is required. See MPEP § 608.01(b).

Applicant is reminded of the proper language and format for an abstract of the disclosure.

The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words. It is important that the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the printer is limited. The form and legal phraseology often used in patent claims, such as "means" and "said," should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc.

### ***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double

patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-6 and 15-17 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-6 and 15-17 of U.S. Patent No. 6,516,179. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims of US Patent No. 6,516,179 reads on the claims of the instant invention.

Claim 1 of US Patent No. 6,516,179 recites the same elements as the instant invention's claim 1, that is an image carrier; an elastic transfer member; a first guide member with a first restriction point; a second guide member with a second restriction point; the second restriction point is located downstream of the first restriction point in a direction of the conveyance of recording medium; a reference plane that reads on the instant invention's reference line is defined by the nip of transfer member and image carrier and the second restriction point; the first restriction point is located on one side of the reference line and the image carrier is located on the second side of the reference line. Claim 2 of US Patent No. 6,516,179 recites the same elements of claim 2 of the instant invention such as the free end of the first guide member is deformable such that when the trailing edge of the recording medium is moves away form the free end, the free end adjoins the reference line. Claim 3 of US Patent No. 6,516,179 recites the same elements of claim 3 of the instant invention such as the free end of the first guide member is formed of an elastic material so as to be deformable when the recording

medium excerpts a force on the free end when leaving the free end. Claim 4 of US Patent No. 6,516,179 recites the same elements of claim 4 of the instant invention such as the recording medium initially contacts the image carrier at a distance of 3 mm to 30 mm from the nip. Claim 5 of US Patent No. 6,516,179 recites the same elements of claim 5 of the instant invention. Claim 6 of US Patent No. 6,516,179 recites the same elements of claim 6 of the instant invention. Claim 15 of US Patent No. 6,516,179 recites the same elements of claim 15 of the instant invention. Claim 16 of US Patent No. 6,516,179 recites the same elements of claim 16 of the instant invention. Claim 17 of US Patent No. 6,516,179 recites the same elements of claim 17 of the instant invention.

***Allowable Subject Matter***

Claims 7-14 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. None of the prior art discloses nor suggests the first restriction point is not deformable.

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Satou et al., Benedict, Nagaoka et al., Ichinose et al., Hiramoto et al., OuYang et al., Hirao et al., Fujii et al., Kamitamari et al., Kanemitsu et al., Sato (Japan, 563) and Hayama (Japan, 481) were disclosed as prior art in parent application 10/306,004 or 09/696,959 but not listed in any PTO-1449 in the instant application.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Susan S. Lee whose telephone number is 571-272-


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2137. The examiner can normally be reached on Mon. - Fri., 10:30-8:00, Second Monday Off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Art Grimley can be reached on 571-272-2136 or 571-272-2800 (Ext. 52).

The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Susan S. Lee  
Primary Examiner  
Art Unit 2852

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